

### **REMARKS**

Claims 1, 2 and 4-9 are pending. No amendments have been made by way of the present submission, thus, no new matter has been added.

In view of the following remarks, Applicants respectfully request that the Examiner withdraw all rejections and allow the currently pending claims.

#### **Issues Under 35 U.S.C. §103(a)**

The Examiner has rejected claims 1, 2, 4 and 6-9 under 35 U.S.C. § 103(a) as being obvious over Inoue et al., USP 4,978,603 (hereinafter referred to as Inoue '603) in view of Saito, USP 6,673,530 (hereinafter referred to as Saito '530). Applicants respectfully traverse this rejection.

#### **The Present Invention and its Advantages**

The present invention relates to a process for the preparation of an emulsion of silver halide fine grains having a number-average equivalent circle diameter of 100 nm or less and coefficient of variation in equivalent circle diameter of 40% or less, wherein the fine grains are prepared via at least one Ostwald ripening step, and wherein the silver halide fine grains are continuously prepared using a device substantially free of residence portion.

Thus, the invention requires that the silver halide fine grains be continuously prepared using a device substantially free of residence portion. However, the cited references fail to suggest or disclose such a limitation.

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Distinctions Between the Present Invention and the Cited Art

Inoue '603 fails to suggest or disclose the continuous preparation of silver halide fine grains using a device substantially free of residence portion. This fact was argued in the previous response and has been acknowledged by the Examiner at page 2, last two lines of the Office Action dated June 29, 2005.

Nonetheless, the Examiner has cited Saito '530 as allegedly disclosing a method of preparing silver halide grains in which the grains are formed employing an apparatus substantially free of a residence portion, wherein the grains are continuously formed and are more monodisperse. Thus, the Examiner asserts that it would have been obvious to prepare the grains of Inoue '603 by employing the apparatus of Saito '530 with a reasonable expectation of achieving a material having a high contrast. Applicants respectfully disagree with the Examiner's characterization of the prior art, in particular the Saito '530 reference.

Saito '530 discloses a method for the production of a silver halide emulsion which comprises (i) storing a mother liquor containing the silver halide grain nuclei produced by instantaneously mixing, and (ii) growing a grain by instantaneously mixing the mother liquor as stored in step (i) with separately obtained addition liquid containing silver halide ultrafine grains for growth. In the above step (i), the produced mother liquor containing the silver halide grain nuclei is continuously "stored;" consequently, Saito '530 has a "residence portion." However, as mentioned above, the present invention, for instance, as embodied in claim 1, continuously prepares silver halide fine grains using a device "substantially free of residence portion."

Therefore, even if Saito '530 is combined with Inoue '603 as suggested by the Examiner, the present invention cannot be achieved.

In addition, according to Saito '530, the silver halide ultrafine grains for growth used in step (ii) above are mixed with the mother liquor as stored in step (i) above immediately following their production. Therefore, silver halide ultrafine grains for growth in Saito '530 are not employed in an "Ostwald ripening step." In contrast, claim 1 of the present invention requires that the fine grains be prepared "via at least one Ostwald ripening step." The Examiner cannot select one aspect of Saito '530 (e.g., the type of apparatus) and ignore others (e.g., the lack of an Ostwald ripening step) when combining teachings with Inoue '603.

Therefore, Applicants submit that there exists no *prima facie* case of obviousness. First, both the primary reference of Inoue '603 and the secondary reference of Saito '530 fail to suggest or disclose continuously preparing silver halide fine grains using a device "substantially free of residence portion." Second, there exist aspects of Saito '530, for instance, the lack of disclosure that the fine grains be prepared "via at least one Ostwald ripening step," which are inconsistent with the teachings of Inoue '603. Therefore, even if Saito '530 were to be combined with Inoue '603, the presently claimed subject could not be achieved. Accordingly, when the references are taken in combination, there exists no *prima facie* case of obviousness and thus, this rejection should be withdrawn.

The Examiner has also rejected claim 5 under 35 U.S.C. 103(a) as being obvious over Inoue '603 in view of Saito '530 and Ichikawa et al., USP 5,270,159 (hereinafter referred to as Ichikawa '159). Applicants traverse this rejection.

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Distinctions between the presently claimed subject matter and Inoue '603 and Saito '530 were discussed above. The reference of Ichikawa '159 fails to cure any of these deficiencies. For instance, without the disclosure of continuous preparation of silver halide fine grains using a device "substantially free of residence portion" there can be no *prima facie* case of obviousness. Thus, even of the references of Inoue '603, Saito '530 and Ichikawa '159 are taken in combination, there exists no motivation to arrive at the presently claimed subject matter. Accordingly, this rejection is improper. Reconsideration and withdrawal thereof are respectfully requested.

In view of the above, Applicants respectfully submit that the present claims define subject matter which is patentable over the cited art. Accordingly, the Examiner is respectfully requested to withdraw all rejections and allow the currently pending claims.


If the Examiner has any questions or comments, please contact Craig M. McRobbie (Registration No. 42,874) at the offices of Birch, Stewart, Kolasch & Birch, LLP.

Pursuant to 37 C.F.R. §§ 1.17 and 1.136(a), Applicants respectfully petition for a three (3) month extension of time for filing a reply in connection with the present application, and the required fee is attached hereto.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. § 1.16 or under § 1.17; particularly, extension of time fees.

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Respectfully submitted,

f By  #42-874  
Marc S. Weiner  
Registration No.: 32,181  
BIRCH, STEWART, KOLASCH & BIRCH, LLP  
8110 Gatehouse Road  
Suite 100 East  
P.O. Box 747  
Falls Church, Virginia 22040-0747  
(703) 205-8000  
Attorney for Applicant

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